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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/529,289 04/07/00 ALMOG

Y UDS

EXAMINER

IM52/1010

WILLIAM H DIPPERT
COWAN LIEBOWITZ AND LATMAN
1133 AVENUE OF THE AMERICAS
NEW YORK NY 10036-6799

YU, L ART UNIT	PAPER NUMBER
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1774
DATE MAILED:

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10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/529,289	Applicant(s) ALMOG ET AL.	
	Examiner Ling Xu	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-12, 14-30, 32 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-3, 7-12, 14-30, 32 and 37-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 20) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

1. Applicants' amendments filed on 8/17/2001 have been entered. Claims 4-6, 13, 31 and 33-36 have been cancelled. Claims 42-45 have been added. The present application contains claims 1-3, 7-12, 14-30, 32, and 37-45.

Lack of Unities Election/Restrictions

2. Applicants' remarks regarding the lack of unity requirement have been fully considered but they are not found persuasive.

Initially, applicants argue that claim 30 (Group II) drawn to a method of producing a substrate of claims 1, 33, 42-43 (Group I) and claim 37 (Group III) drawn to a method of use the product as such that there can not be non-unity between Groups I, II, and III. However, the lack of unity restrictions is based on the special technical feature, which shared by these three groups, does not defined a contribution over the prior art, Keil, as stated in the prior Office action. Applicants wrongly assert that the Keil reference does not teach the special technical feature of the substrate. Keil teaches Mylar on a polyolefin sheet including the same layers structure as the applicants' substrate. Therefore, a lack of unity exists.

Also, applicant has misquoted Examiner Dote's statement concerning the special technical feature in Groups I-III. The previous Examiner merely stated that special technical feature showed no contribution over the prior art. Thus, lack of unity exists

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because the special technical feature, which shared by these three groups, does not defined a contribution over the prior art, Keil, as stated in the prior Office action.

Lastly, Applicants' assertion that the dependent claims 37-41 have features of the parent claims, thus no lack of unity exist, is incorrect. Claims 37-41 are drawn to method of printing using the substrate, which is claimed in claim 1. Again, because the special technical feature shows no contribution over the prior art, Keil, lack of unity exists.

Therefore, the lack of unity requirement of the last Office action of 6/14/2001 is proper.

3. Applicants have amended the claims in an attempt to overcome lack of unity restriction requirement. However, lack of unity restriction requirement continues to exist even though some claims have been cancelled, new claim 42 has been added to overcome the special technical feature shown by reference EP'281 in the previous Office action by adding a thickness. Claims 42-44 will be prosecuted with the group containing claim 1. Claim 45 will be grouped with claim 30.

This amendment may alter the lack of unity restriction requirement but does not make it improper. Consequently, the Examiner will examine Group I as defined below:

Group I contains claims 1-3, 7-12, 14-29, 32, 42-44, drawn to a substrate;

Group II contains claims 30 and 45, drawn to a method of producing a coated substrate;

Group III contains claims 37-41, drawn to a painting method.

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All of these claims have the substrate as the special technical feature as shown by Keil and thus provide not contribution over the prior art as stated previously.

Applicants' election of Group I and species 25 in claims 11, 14-18 and 20 is acknowledged. The following elected species with claims 11, 14-18 and 20 will be searched and examined initially:

- Plastic sheet is BOPP (claims 11 and 43)
- Overlayer- ethylene acrylic acid copolymer (claims 14-18, 43)
- Under layer is amine terminated polyamide (claim 20)

Claims 1-3, 23-29, 32, 42 and 44 are generic claims.

Claims 1-3, 11, 14-18, 20, 23-29, 32, 42-44 read on the elected species and will be examined with respect to the elected species. Claims 7-10, 12, 19, 21-22, 30, 37-41 and 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

The lack of unity requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 11, 14-18, 20, 23-29, 32, 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 2-3 and 28, the phrase "substantially free of" is a relative is a relative term, which renders the claim indefinite. The term "substantially free of" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how much "free of" is considered "substantially".

In claim 11, "BOPP" should be defined.

In claim 29, the language "comprising only two coating layers" is confusing. The language "comprising" is an open language. It is unclear, if only two coating layers should be present or there are more than two layers.

Claims 2-3, 14, 20, 23-24, 28-29 recites the limitation "overlayer" and "underlayer". There is insufficient antecedent basis for this limitation in the claims with respect to the independent claim 43 because claim 43 merely recites the substrate comprising "an outer coating".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-3, 11, 14-18, 25-27, 29, 32, 43-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Touhsaent (US 5,419,960).

Touhsaent discloses a coated film comprising:

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- a base polymer film made of polyolefins such as polypropylene BOPP (Col. 5, lines 63-65) polyethylene, or polyesters such as PET (Col. 3, lines 40-46).
- a coated layer comprising a composition comprising a copolymer of about 65 to 95 wt % ethylene and about 5 to 35 wt % of acrylic, or methacrylic acid (an "ethylene copolymer") (Abstract) and having a thickness of 0.02 to about 0.10 mil thickness (Col. 5, lines 30-35). The thickness is within the ranges recited in claims 43-44.

Touhsaent also discloses that the total coating weight on the film surface following drying of the film was from about 0.5 to 0.9 gram/1000 square in (Col. 6, lines 15-25), which is within the ranges recited in claims 25-27.

Touhsaent further discloses that a substrate comprises two coating layers (Col. 3, lines 47-55).

It is noted that claim 32 is a product-by-process claim. Product-by-process claim is not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). "[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966.

The preamble recitation of a substrate "suitable for printing a toner image" places no positive limitations on the claimed substrate, it merely indicates the intended use of the substrate.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 11, 14-18, 20, 23-29, 32, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Touhsaent et al in view of Ueno et al (US 6,040,268)

As stated above, Touhsaent discloses a coated film comprising:

A base polymer film made of polyolefins such as polypropylene BOPP (Col. 5, lines 63-65) and polyethylene, polyesters such as PET (Col. 3, lines 40-46).

A coated layer comprising a composition comprising a copolymer of about 65 to 95 wt % ethylene and about 5 to 35 wt % of acrylic, or methacrylic acid (an "ethylene copolymer" (Abstract) and having a thickness of 0.02 to about 0.10 mil thickness (Col. 5, lines 30-35). The thickness is within the ranges recited in claims 43-44.

Touhsaent also discloses that the total coating weight on the film surface following drying of the film was for, about 0.5 to 0.9 gram/1000 square in (Col. 6, lines 15-25), which is within the ranges recited in claims 23-27.

Touhsaent discloses that an intermediate primer coating can be employed where greater coating-to film adherence is desired (Col. 5, lines 5-10). Touhsaent does not disclose the intermediate primer or underlayer comprises amine-terminated polyamide.

Ueno teaches the use of an adhesive layer made of polyamide resins (Col. 8, lines 15-32 and Col. 20, Example A). Ueno also teaches that the adhesive layer has excellent adhesion to the substrate (Col. 2, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art to use polyamide resins as adhesive material for Touhsaent's intermediate primer coating layer because polyamide resins provide excellent adhesion to the substrate, as taught by Ueno.

It is noted, as stated above, that claim 32 is a product-by-process claim. Product-by-process claim is not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling Xu whose telephone number is 703-305-0395. The examiner can normally be reached on 8:00 - 4:30 Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9614 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

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LX
October 4, 2001

A handwritten signature in cursive script, appearing to read "Cynthia H. Kelly", is written over the typed name and title.